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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10007711-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Phyllis A. Ellendman

Confirmation No.: 8593

Application No.: 09/916,971

Examiner: Michael Roswell

Filing Date: July 26, 2001

Group Art Unit: 2173

Title: E-MAIL DISTRIBUTION WITH VERSATILE ADDRESS REMOVAL

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 13, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month  
\$120

☐ 2nd Month  
\$450

☐ 3rd Month  
\$1020

☐ 4th Month  
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Phyllis A. Ellendman

By Douglas L. Weller

Douglas L. Weller

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**SUBJECT:** E-MAIL DISTRIBUTION WITH VERSATILE ADDRESS REMOVAL

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**COMMISSIONER FOR PATENTS**

**P.O. Box 1450**

**Alexandria, VA 22313-1450**

**Sir:**

**APPEAL BRIEF**

Appellant herein sets forth his reasons and arguments for appealing the Examiner's final rejection of claims in the above-identified case.

**REAL PARTY IN INTEREST**

This Patent Application has been assigned to Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business in Houston, Texas.

**RELATED APPEALS AND INTERFERENCES**

Appellant is aware of no related appeals or interferences.

### **STATUS OF CLAIMS**

Claims 1 through 14 are pending in the case.

Claims 1 through 14 are rejected.

The appealed claims are claims 1 through 14.

### **STATUS OF AMENDMENTS**

After the final rejection, Appellant filed a Response dated March 29, 2006.

The Response did not include any amendments to the case.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

#### **Claim 1:**

Claim 1 sets out a method by which an electronic mail system sends an electronic message. In preparation for sending an e-mail message (11,20), the electronic mail system checks a field (26) of the e-mail message used to specify addresses to be removed by the electronic mail system from a "To" field (21). The electronic mail system removes from any addresses specified in the "To" field (21) of the e-mail message, any addresses within the field (26) of the e-mail message used to specify addresses to be removed from the "To" field (21). The e-mail message (11,20) is then sent. An example of a "To" field (21) and a "Remove" field (26) is shown in Figure 2. See, for example, the Specification at page 3, line 19 through page 5, line 10.

**Claim 8:**

Claim 8 sets out a method by which an electronic mail system sends an electronic message. In preparation for sending an e-mail message (11,20,60), the electronic mail system checks a field of the e-mail message used to specify addresses to be removed by the electronic mail system from all address fields. The electronic mail system removes from any addresses specified in a “To” field (21,61), a “Cc” field (22,62) and a “Bcc” field (23,63) of the e-mail message (11,20,60) any addresses within the field (24,64) of the e-mail message used to specify addresses to be removed from all address fields. The e-mail message (11,20,60) is then sent.

An example of a “To” field (21), a “Cc” field (22), a “Bcc” field (23) and a “Remove” field (26) is shown in Figure 2. See, for example, the Specification at page 3, lines 14 through 18 and at page 6, line 22 through page 7, line 5.

Another example of a “To” field (61), a “Cc” field (62), a “Bcc” field (63) and a “Remove” field (64) is shown in Figure 6. See, for example, the Specification at page 1, lines 1 through 6.

**Claim 9:**

Claim 9 sets out an electronic mail system for generating a message (11,20,60) for being sent electronically. The message comprises a “To” field (21,61) for listing primary addresses to receive the message, and a field (26,64)

used to specify, to the electronic mail system, addresses to be removed by the electronic mail system from the “To” field (21,61) in preparation for sending the message.

An example of a “To” field (21) and a “Remove” field (26) is shown in Figure 2. See, for example, the Specification at page 3, line 19 through page 5, line 10.

Another example of a “To” field (61), and a “Remove” field (64) is shown in Figure 6. See, for example, the Specification at page 1, lines 1 through 6.

**Claim 14:**

Claim 14 sets out an electronic mail system for generating a message (11,20,60) for being sent electronically, the message comprises a plurality of address fields. The address fields include a “To” field (21,61) for listing primary addresses to receive the message; a “Cc” field (22,62) for listing addresses to receive a copy of the message; a “Bcc” field (23,63) for listing addresses to receive a blind copy of the message; and, a field (24,64) used to specify, to the electronic mail system, addresses to be removed by the electronic mail system from the address fields in preparation for sending the message.

An example of a “To” field (21), a “Cc” field (22), a “Bcc” field (23) and a “Remove” field (26) is shown in Figure 2. See, for example, the Specification at page 3, lines 14 through 18 and at page 6, line 22 through page 7, line 5.

Another example of a "To" field (61), a "Cc" field (62), a "Bcc" field (63) and a "Remove" field (64) is shown in Figure 6. See, for example, the Specification at page 1, lines 1 through 6.

#### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

(1) Claims 1 to 14 stand rejected under 35 U.S.C. § 102 (e) as anticipated by USPN 6,671,718 (*Meister*).

#### **ARGUMENT**

##### **A. Overview of Errors in the Rejection of the Claims under 35 U.S.C. 102.**

The criteria for a rejection under 35 U.S.C. § 102(b) has been defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has failed to show that each and every element set forth in the claims is found either expressly or inherently by the cited art.

## **B. Discussion of claims 1 through 7**

Independent claim 1 sets out a method by which an electronic mail system sends an electronic message. In preparation for sending an e-mail message, the electronic mail system checks a field of the e-mail message used to specify addresses to be removed by the electronic mail system from a "To" field. The electronic mail system removes from any addresses specified in the "To" field of the e-mail message, any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field. The e-mail message is then sent.

### Subject Matter within Independent Claim 1 not Disclosed by *Meister*

*Meister* does not disclose or suggest that an electronic mail system checks a field of an e-mail message used to specify addresses to be removed by the electronic mail system from a "To" field, as set out by claim 1 of the present case.

*Meister* does not disclose or suggest that an electronic mail system removes from any addresses specified in the "To" field of the e-mail message, any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field, as set out by claim 1 of the present case.

### What *Meister* Discloses

*Meister* allows a user to manually remove addresses from a “To” field of an e-mail message. See *Meister* at Figure 6 and column 5, lines 17 through 27. However, *Meister* does not disclose or suggest the use of a field of the e-mail message used to specify addresses to be removed from the “To” field.

### Errors the Examiner Made in Rejection

The Examiner has argued that in *Meister* a “Modify Addresses” control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2 of *Meister*, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 1 of the present case.

For example, step (a) of claim 1 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from a “To” field. The modify addressees control 46 disclosed in *Meister* does not disclose or suggest such a field of an e-mail message.

Likewise, step (a) of claim 1 sets out that the electronic system removes from any addresses specified in the “To” field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from the “To” field. This is not disclosed or suggested by the modify addressees control 46 disclosed in *Meister*.



As discussed above, the language of claim 1 specifically requires a *field* of the e-mail message be used to specify addresses to be removed from a "To" field. The Examiner has made no attempt to show that an e-mail message shown by *Meister* includes such a *field*. Rather, *Meister* only discloses a *control* which allows a user to manually remove addresses from a "To" field of an e-mail message. See *Meister* at Figure 6 and column 5, lines 17 through 27. Any person of ordinary skill in the art would recognize that the *control* disclosed by *Meister* is not a *field* of an e-mail message, as set out in claim 1 of the present case. Therefore, it is clear that claim 1 is not anticipated by *Meister*.

The Examiner further argued as follows:

In response to Applicant's argument that *Meister* fails to teach the use of a field of the email message used to specify addresses to be removed from the "To" field, the Examiner respectfully disagrees. *Meister* has been shown to teach a control that allows a user to select addresses to be removed by the e-mail system before the sending of the message. The Examiner contends that this control is part of the e-mail message as it allows the user to send the message by way of the "OK" button 44 of Fig. 2, and further edit the message by way of a message modification control as described at col. 3, lines 51-56. Therefore, the Examiner maintains the rejection of the claims over *Meister*.

The Examiner's discussion of *Meister* ignores the language of the claims of the present case. For example, claim 1 includes the following language: "a field of the e-mail message used to specify addresses to be removed by the electronic mail system from a 'To' field." Thus the language of claim 1 specifically requires a *field* of the e-mail message be used to specify addresses to be removed from a "To" field.

The Examiner has made no attempt to show that an e-mail message shown by *Meister* includes such a *field*. Rather, *Meister* only discloses a *control* which allows a user to manually remove addresses from a "To" field of an e-mail message. See *Meister* at Figure 6 and column 5, lines 17 through 27.

Anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to anticipate. *Glaverbel Société Anonyme v. Northlake Marketing & Supply Inc.*, 45 F.3d 1550, 33 U.S.P.Q. 2d 1496, 1498 (Fed Cir. 1995). "[A]ny degree of physical difference, however slight, invalidates claims of anticipation". *Ultradent Products Inc. v. Life-Like Cosmetics Inc.*, 39 U.S.P.Q.2d 1969,1980 (Utah 1996).

Any person of ordinary skill in the art would recognize that the *control* disclosed by *Meister* is not a *field* of an e-mail message, as set out in claim 1 of the present case. There is a significant and undeniable difference between a field of an e-mail message and a control feature within an email client application. Therefore, it is clear that claim 1 of the present case is not anticipated by *Meister*.

### C. Discussion of claim 8

Independent claim 8 sets out a method by which an electronic mail system sends an electronic message. In preparation for sending an e-mail message, the electronic mail system checks a field of the e-mail message used to specify addresses to be removed by the electronic mail system from all address

fields. The electronic mail system removes from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from all address fields. The e-mail message is then sent.

#### Subject Matter within Independent Claim 8 not Disclosed by *Meister*

*Meister* does not disclose or suggest that in preparation for sending an e-mail message, an electronic mail system checks a field of the e-mail message used to specify addresses to be removed by the electronic mail system from all address fields, as set out in claim 8 of the present case.

*Meister* does not disclose or suggest that an electronic mail system removes from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from all address fields.

#### Errors the Examiner Made in Rejection

The Examiner has argued that in *Meister* a "Modify Addresses" control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49 of *Meister*. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 8 of the present case.

For example, step (a) of claim 8 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from all address fields. The modify addressees control 46 does not disclose or suggest such a field of an e-mail message.

Likewise, step (a) of claim 8 sets out that the electronic system removes from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from all address fields. This is not disclosed or suggested by the modify addressees control 46 disclosed in *Meister*.

As discussed above, the language of claim 8 specifically sets out a *field of the e-mail message* used to specify addresses to be removed by the electronic mail system from all address fields. The Examiner has made no attempt to show that an e-mail *message* shown by *Meister* includes such a *field*. Rather, *Meister* only discloses a *control* which allows a user to manually remove addresses from an e-mail message. See *Meister* at Figure 6 and column 5, lines 17 through 27. Any person of ordinary skill in the art would recognize that the *control* disclosed by *Meister* is not a *field* of an e-mail message, as set out in claim 8 of the present case. Therefore, it is clear that claim 8 is not anticipated by *Meister*.

#### **D. Discussion of claims 9 through 13**

Independent claim 9 sets out an electronic mail system for generating a message for being sent electronically. The message comprises a "To" field for listing primary addresses to receive the message, and a field used to specify, to

the electronic mail system, addresses to be removed by the electronic mail system from the “To” field in preparation for sending the message.

Subject Matter within Independent Claim 9 not Disclosed by *Meister*

*Meister* does not disclose or suggest a message that comprises a “To” field for listing primary addresses to receive the message, and a field used to specify, to the electronic mail system, addresses to be removed from the “To” field in preparation for sending the message.

Errors the Examiner Made in Rejection

The Examiner has argued that in *Meister* a “Modify Addresses” control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 9 of the present case.

Particularly, claim 9 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from a “To” field. The modify addressees control 46 does not disclose or suggest such a field of an e-mail message.

As discussed above, the language of claim 9 specifically sets out that a message includes a *field* used to specify, to the electronic mail system, addresses

to be removed by the electronic mail system from the “To” field in preparation for sending the message. The Examiner has made no attempt to show that an e-mail message shown by *Meister* includes such a *field*. Rather, *Meister* only discloses a *control* which allows a user to manually remove addresses from an e-mail message. See *Meister* at Figure 6 and column 5, lines 17 through 27. Any person of ordinary skill in the art would recognize that the *control* disclosed by *Meister* is not a *field* of a message, as set out in claim 9 of the present case. Therefore, it is clear that claim 9 is not anticipated by *Meister*.

#### **E. Discussion of claim 14**

Independent claim 14 sets out an electronic mail system for generating a message for being sent electronically, the message comprises a plurality of address fields. The address fields include a “To” field for listing primary addresses to receive the message; a “Cc” field for listing addresses to receive a copy of the message; a “Bcc” field for listing addresses to receive a blind copy of the message; and, a field used to specify, to the electronic mail system, addresses to be removed by the electronic mail system from the address fields in preparation for sending the message.

#### **Subject Matter within Independent Claim 14 not Disclosed by *Meister***

*Meister* does not disclose or suggest an electronic mail system that generates a message, where the message includes a field used to specify, to the electronic mail system, addresses to be removed by the electronic mail system

from the address fields in preparation for sending the message.

### Errors the Examiner Made in Rejection

The Examiner has argued that in *Meister* a “Modify Addressees” control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 14 of the present case.

Particularly, claim 14 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from address fields of a message. The modify addressees control 46 does not disclose or suggest such a field of a message.

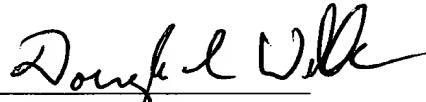
As discussed above, the language of claim 14 specifically sets out that a message includes a *field* used to specify, to the electronic mail system, addresses to be removed by the electronic mail system from the address fields in preparation for sending the message. The Examiner has made no attempt to show that an e-mail message shown by *Meister* includes such a *field*. Rather, *Meister* only discloses a *control* which allows a user to manually remove addresses from an e-mail message. See *Meister* at Figure 6 and column 5, lines 17 through 27. Any person of ordinary skill in the art would recognize that the

*control* disclosed by *Meister* is not a *field* of a message, as set out in claim 14 of the present case. Therefore, it is clear that claim 14 is not anticipated by *Meister*.

### CONCLUSION

For all the reasons discussed above, Appellant believes the rejection of the claims was in error and respectfully requests that the rejection be reversed.

Respectfully submitted,  
PHYLLIS A. ELLENDMAN

By   
Douglas L. Weller  
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June 7, 2006  
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## CLAIMS APPENDIX

1. (Previously Presented) A method by which an electronic mail system sends an electronic message comprising the following steps:

(a) in preparation for sending an e-mail message, performing the following by the electronic mail system:

checking by the electronic mail system a field of the e-mail message used to specify addresses to be removed by the electronic mail system from a "To" field, and

removing by the electronic mail system from any addresses specified in the "To" field of the e-mail message, any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field; and,

(b) sending the e-mail message.

2. (Previously Presented) A method as in claim 1 wherein step (a) additionally comprises the following:

removing from any addresses specified in a "Cc" field, any addresses within a field used to specify addresses to be removed from the "Cc" field.

3. (Previously Presented) A method as in claim 1 wherein step (a) additionally comprises the following:

removing from any addresses specified in a "Bcc" field, any addresses within a field used to specify addresses to be removed from the "Bcc" field.

4. (Previously Presented) A method as in claim 1 wherein at least a subset of addresses to be removed from the "To" field are specified using a group list.

5. (Previously Presented) A method as in claim 1 wherein at least a subset of addresses to be removed from the "To" field are specified using at least one group list and at least one individually listed address.

6. (Previously Presented) A method as in claim 1 wherein step (a) additionally comprises the following:

removing from any addresses specified in the "To" field, any addresses within a field used to specify addresses to be removed from all address fields.

7. (Previously Presented) A method as in claim 1 wherein step (a) additionally comprises the following:

removing from any addresses specified in a "Cc" field, any addresses within a field used to specify addresses to be removed from the "Cc" field;

removing from any addresses specified in a "Bcc" field, any addresses within a field used to specify addresses to be removed from the "Bcc" field; and,

removing from any addresses specified in the "To" field, the "Cc" field and the "Bcc" field any addresses within a field used to specify addresses to be removed from all address fields.

8. (Previously Presented) A method by which an electronic mail system sends an electronic message comprising the following:

in preparation for sending an e-mail message, performing the following:

checking by the electronic mail system a field of the e-mail message used to specify addresses to be removed by the electronic mail system from all address fields, and

removing by the electronic mail system from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from all address fields; and,

sending the e-mail message.

9. (Previously Presented) An electronic mail system for generating a message for being sent electronically, the message comprising the following fields:

a "To" field for listing primary addresses to receive the message; and,

a field used to specify, to the electronic mail system, addresses to be removed by the electronic mail system from the "To" field in preparation for sending the message.

10. (Original) An electronic mail system as in claim 9, the message additionally comprising the following fields:

a "Cc" field for listing addresses to receive a copy of the message; and,

a field used to specify addresses to be removed from the "Cc" field in preparation for sending the message.

11. (Original) An electronic mail system as in claim 9, the message additionally comprising the following fields:

a "Bcc" field for listing addresses to receive a blind copy of the message;  
and,

a field used to specify addresses to be removed from the "Bcc" field in preparation for sending the message.

12. (Original) An electronic mail system as in claim 9, the message additionally comprising the following field:

a field used to specify addresses to be removed from all address fields in preparation for sending the message.

13. (Original) An electronic mail system as in claim 9, the message additionally comprising the following fields:

a "Cc" field for listing addresses to receive a copy of the message;  
a "Bcc" field for listing addresses to receive a blind copy of the message;  
and,  
a field used to specify addresses to be removed from all address fields in preparation for sending the message.

14. (Previously Presented) An electronic mail system for generating a message for being sent electronically, the message comprising the following fields:

a plurality of address fields, the address fields comprising:

a "To" field for listing primary addresses to receive the message,

a "Cc" field for listing addresses to receive a copy of the message,

and

a "Bcc" field for listing addresses to receive a blind copy of the message; and,

a field used to specify, to the electronic mail system, addresses to be removed by the electronic mail system from the address fields in preparation for sending the message.

### **EVIDENCE APPENDIX**

No evidence under §§ 1.130, 1.131, or 1.132 is relied upon by Appellant in the appeal.

### **RELATED PROCEEDINGS APPENDIX**

There are no related decisions rendered by a court or the Board.